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Supreme Court of the United States

OCTOBER TERM, 1941

No. 1024

TAMPAX INCORPORATED and TAMPAX
SALES CORPORATION

Petitioners

vs.

THE PERSONAL PRODUCTS CORPORATION and
ISIDORE H. SCHWARTZ, trading as HIGHLAND
PHARMACY

Respondents

**PETITION FOR WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE SECOND
CIRCUIT AND BRIEF IN SUPPORT THEREOF**

H. STANLEY MANSFIELD
W. BROWN MORTON

Counsel for Petitioners



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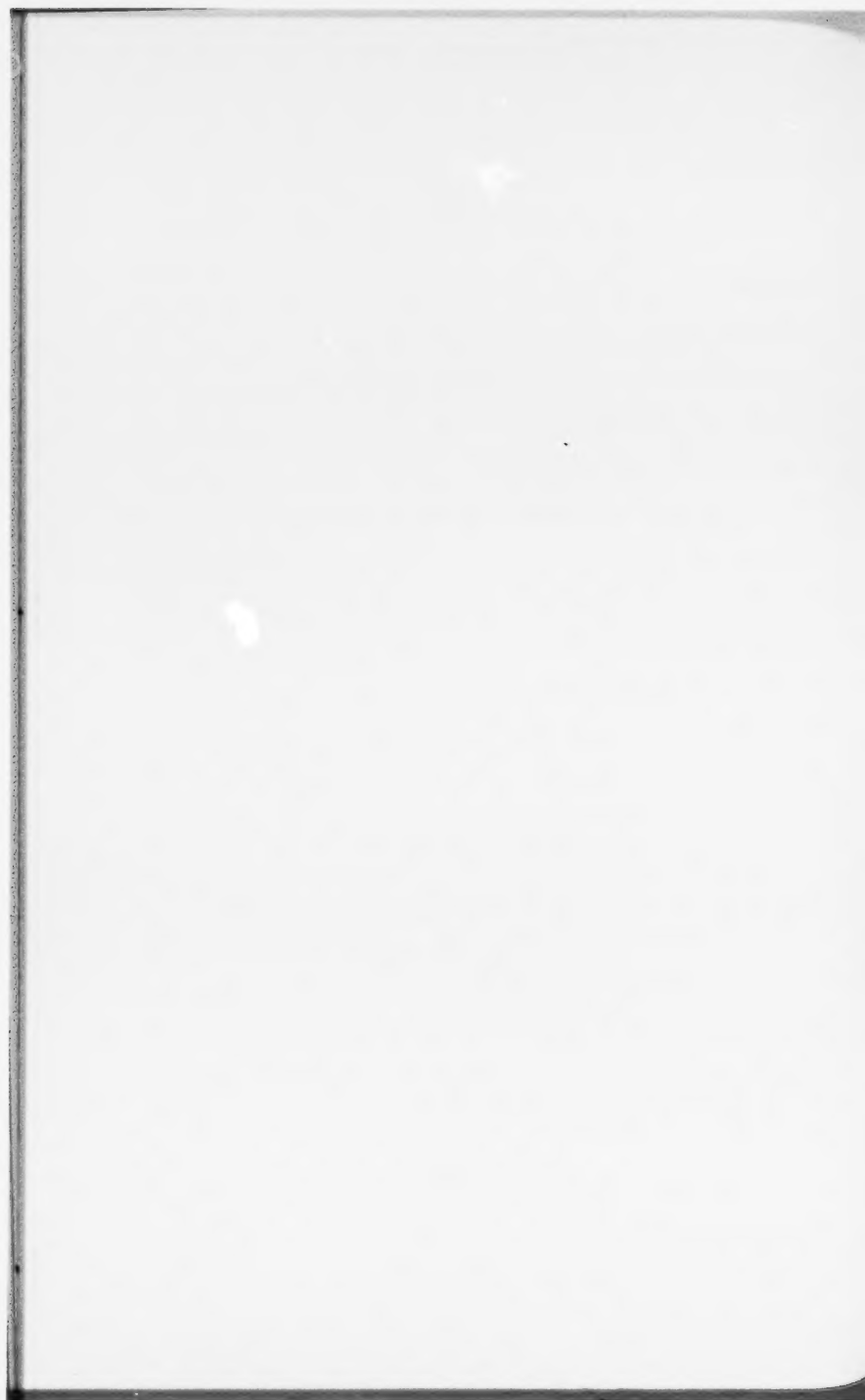
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Respondents

PETITION FOR WRIT OF CERTIORARI

*To the Honorable, the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Your petitioners, Tampax Incorporated and Tampax Sales Corporation, pray that a writ of certiorari issue to review the decision of the United States Circuit Court of Appeals for the Second Circuit entered herein on the 24th day of November, 1941 (R. 505). Rehearing and reconsideration by that Court were requested and were denied on the 10th day of December, 1941 (R. 518).

A certified transcript of the record of the case, including the proceedings in the Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

Opinions Below

The opinion of the District Court appears in 38 F. Supp. 663, and the opinion of the Circuit Court of Appeals for the Second Circuit in 123 F. (2d) 722.

Summary Statement of the Matter Involved

This is a suit in equity brought by petitioners against respondents in the United States District Court for the Eastern District of New York for, *inter alia*, alleged infringement of claim 1 of U. S. patent No. 1,964,911, granted July 3, 1934. The District Court held claim 1* valid but not infringed, and entered the usual decree dismissing the complaint. On appeal to the Circuit Court of Appeals for the Second Circuit the decree was affirmed. In its opinion the Court of Appeals based its finding of non-infringement on the ground of "file wrapper estoppel", asserting that by the proceedings in the Patent Office the claim is limited to the precise embodiment illustrated in the drawings, notwithstanding the fact that the claim is expressed in broader terms which are definite and unambiguous.

The Patent Office proceedings which the Court of Appeals for the Second Circuit held to create a "file wrapper estoppel" was not an amendment to the claim to secure its allowance. The claim was one of the original claims of the application on which the patent was granted and there was no significant amendment of any sort during the prosecution of that application.

The "file wrapper estoppel" found by the Court of Appeals is based on the inclusion in the specification and drawing of the application for the patent of a more detailed disclosure of the specific article of the patent than was included in the specification and drawing of a prior pending application of the same inventor in which the same claim was presented but not allowed.

*1. A catamenial device comprising: a highly compressed, self-sustaining, absorbent core; and a flexible member secured to and depending from said core to form a withdrawing member, said core comprising a compressed, convoluted strip of absorbent material, said core being considerably shorter than said strip (R. 182).

The application* upon which the patent issued was filed as a continuation in part of an earlier application** filed by the same inventor. The claim in issue was originally presented in the earlier application and was rejected in that application on the ground that the subject-matter of the claim was not sufficiently disclosed in the specification and drawing (R. 282). The applicant thereupon filed a second application with an amplified description and drawing and with the exact claim previously presented in the earlier application. The Court of Appeals for the Second Circuit held that the filing of the second application with the amplified disclosure was analogous to amplifying the disclosure of the first application by amendment and created a "file wrapper estoppel" which required that the claim be limited to the precise embodiment of the invention illustrated in the amplified disclosure notwithstanding the fact that the terms of the claim as clearly defined in the specification required a broader construction.

Question Presented

The question presented by this case is the following:

Does the amplification of the specification and drawing, whether by amendment or by a "continuing" application, to show in greater detail the preferred embodiment of the invention, restrict the scope of the claims to the added details?

Reasons for Granting the Writ

1. The ruling of the Court of Appeals for the Second Circuit denying to the patentee the benefit of a range of equivalents within the scope of the language of the claim

*Ser. No. 672,145, filed May 22, 1933. Pat. No. 1,964,911 (R. 191).

**Ser. No. 576,179, filed Nov. 19, 1931. Pat. No. 1,926,900 (R. 256).

is in direct conflict with the ruling of this Court in *Exhibit Supply Co. v. Ace Patents Corporation*, decided February 2, 1942 (86 L. Ed. 453, Advance Sheets).

2. The ruling of the Circuit Court of Appeals for the Second Circuit that additions to the specification and drawings to illustrate a preferred embodiment of the invention in greater detail creates a file wrapper estoppel which limits the claim to the precise details so added, is in direct conflict with the following decisions of the Courts in the First and Third Circuits.

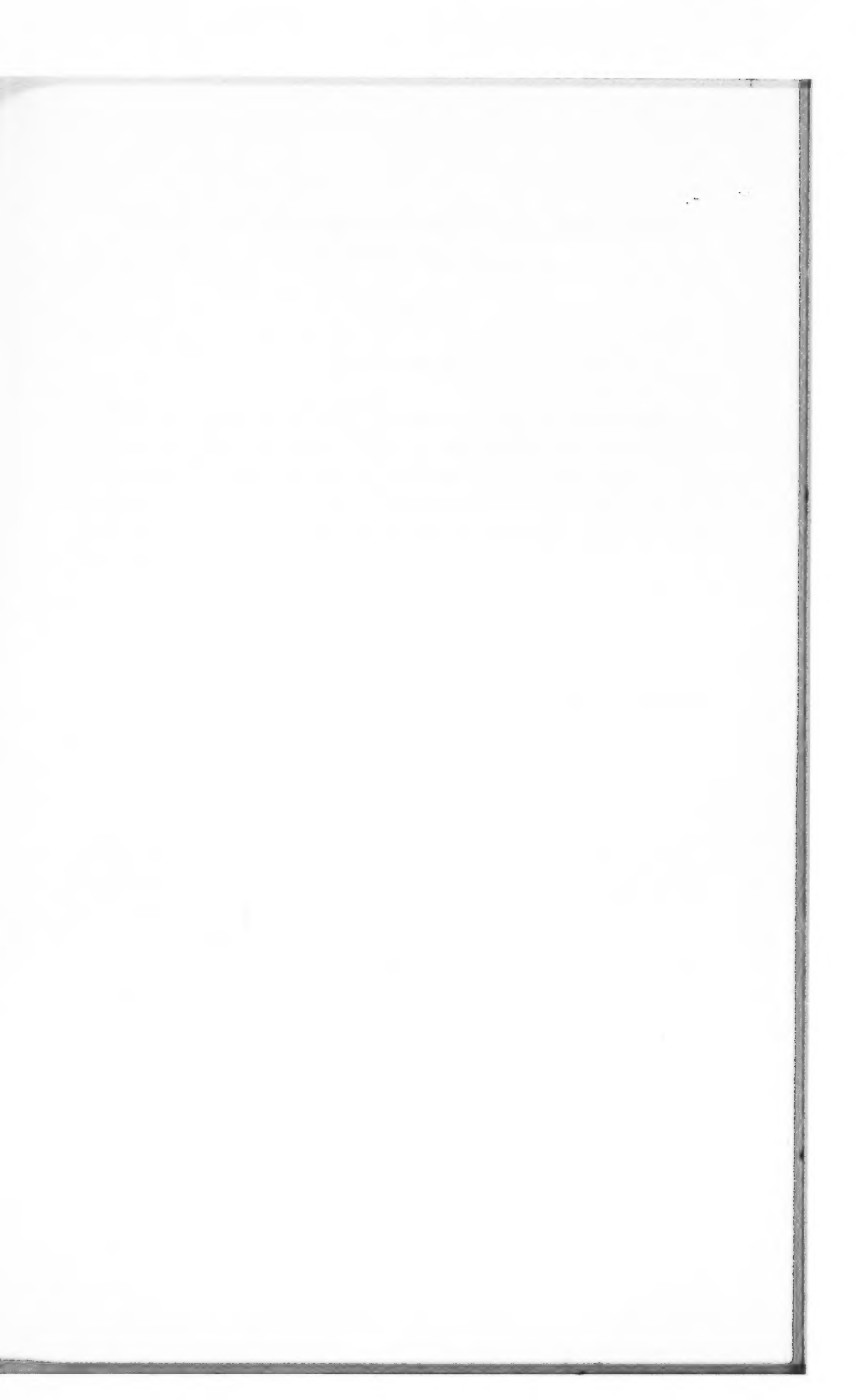
Manhattan General Construction Co. v. Helios-Upton Co., 135 Fed. 785 (C. C. E. D. Pa.);
A. S. Boyle Co. v. Siegel Hardware & Paint Co.,
26 F. Supp. 217 (D. C. Mass.).

3. A decision on the questions here presented is of importance to the public interest. The disclosure of the invention is the consideration paid by the patentee for the limited monopoly of his patent. It is to the public interest that that disclosure include all the necessary detail for the commercial production of the patented article. When the disclosure is insufficient the Patent Office requires additional drawings and description, but patentees will limit their compliance to the least that is acceptable if they thereby limit the scope of the patent beyond the terms of their claims.

WHEREFORE, it is respectfully requested that this petition for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit be granted.

H. STANLEY MANSFIELD
W. BROWN MORTON
Counsel for Petitioners

Dated: New York, N. Y.
March 6, 1942.



BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decree of the Circuit Court of Appeals for the Second Circuit which petitioner seeks to have reviewed was entered December 12, 1941 (R. 519).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for a writ of certiorari.

Specification of Errors

The errors which petitioners will urge if the writ of certiorari is issued, are that the Circuit Court of Appeals for the Second Circuit erred:

1. In holding that the scope of claim 1 is limited by "file wrapper estoppel" to the precise construction illustrated and described in the drawings and specification.
2. In not according to the terms of claim 1 of Patent No. 1,964,911 the meaning expressly set forth in the definitions included in the specification of the patent.
3. In not holding defendants' device to be an infringement of claim 1 of Patent No. 1,964,911.

Summary of Argument

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari.

ARGUMENT

I

The ruling of the Court of Appeals for the Second Circuit denying to the patentee the benefit of a range of equivalents within the scope of the language of the claim is in direct conflict with the ruling of this Court in *Exhibit Supply Company v. Ace Patents Corporation*, decided February 2, 1942 (86 L. Ed. 453, *Advance Sheets*).

In the above mentioned case this Court reviews its former decisions dealing with the question of file wrapper estoppel and restates the governing principles particularly as regards the limits of the estoppel. In view of this recent and comprehensive discussion of the question any reference to prior authorities in this argument would be superfluous.

A file wrapper estoppel is created by an applicant for a patent when he limits the scope of the monopoly defined by his patent claims to meet the objection of the Patent Office that his claims are broader than he is entitled to. As clearly stated by this Court in the above mentioned case, he is not, however, by this action, estopped from claiming *all* benefit of the doctrine of equivalents in construing his claims against infringers. His amendment *limits* the range of equivalents to those structures which fall within the terms of the amended claims, but his patent is infringed by those structures.

In the case at bar the Court of Appeals in its opinion expressly holds that the claim in suit *cannot* be given a construction commensurate with its terms but must be construed as limited to the precise embodiment of the invention illustrated in the drawings.

The device of the patent is a simple article of manufacture. A string is attached to a strip of cotton three or four inches in length, which is then compressed under heavy hydraulic pressure, 2500 pounds to the square inch (R. 24), to a self-sustaining cylindrical plug of a length less than half that of the original strip. Upon the absorption of liquid the plug expands again to its original dimensions, and in so doing it absorbs two or three times its own volume of liquid (R. 34, 309). The advantages of the structure are not in dispute, as is evident from the advertising and direction leaflets of both parties (R. 297, 316).

In compressing a strip of cotton to a shorter length, folds are inevitably produced in the material of the strip. The inventor in his specification and claims used the word "convoluted" to define the folding effected by this longitudinal compression of the strip. The Examiner expressed disagreement with the meaning of the word "convoluted" and suggested that such folds were better defined as "accordion folds". Instead of amending the claim to adopt the Examiner's phraseology, the patentee incorporated in the specification a definition of the word "convoluted" as used in the patent claim (R. 209) to include accordion folds* which, according to the Examiner, are the "natural result of compressing a long strip into a tight core of considerably lesser length". The Court of Appeals so construed the *language* of the claim in its opinion:

"The examiner rejected the claim because he did not like the use of the word, 'convoluted', which to him meant folded like a leaf, 'vernated'. He preferred the word, 'accordion', and said that 'accordion folds are the natural result of compressing a long strip * * * into a tight core of considerably lesser length.' To meet this objection Haas kept the word, 'convoluted', in the claim, but defined it as we have said. If that

*"The words 'convolutions' and 'convoluted' as used herein mean—folded in curved or tortuous, sinuous windings, that is, bending in and out in a serpentine, wavy or accordion folded form."

was all, it might be difficult to say that the introduction of the definition had circumscribed the claim *to the kind of 'convolutions' described in 'the second passage' "*. (Emphasis ours) (Opinion R. 505-506)

The Court of Appeals held, however, that the claim could not be accorded a scope commensurate with its language because of the incorporation in the description and drawings of the second application in which the claim was allowed, of additional descriptive matter not included in the specification of the original application. This descriptive matter is designated as the "second passage" in the Court's opinion and is quoted in the opinion (R. 505).

"The next step in the manufacture of the device is to fold the pad 11 into convolutions such as shown in Fig. 2 to reduce the length thereof. This folded convoluted pad is then placed into a die and pressed under high pressure from both the sides and the end to form a hard cylindrical core 13 with the withdrawing member 12 extending therefrom".

Figure 2 discloses a procedural step in the manufacture of the specific device disclosed in the patent drawings, namely, a pre-folding of the strip to facilitate its insertion and compression in the forming die. This procedural step is recited in claims 2 and 3 of the patent, and these claims are not charged to be infringed. The folds shown in Fig. 2 are described in the Court's opinion (R. 505) as "*regular zigzag folds*" and the Court held claim 1 limited to the "*regular zigzag folds*" disclosed in Figure 2, notwithstanding the broader language of the claim, thereby excluding from the claim an equivalent form of the device *recognized by the patentee and the Patent Office* as within the scope of the claim language, namely, a compressed strip wherein the folds are not regular, zigzag folds, but are the haphazard folds which are "the natural result of compressing a long strip into a tight core of considerably lesser length."

In *Exhibit Supply Company v. Ace Patents Corporation*, *supra*, the petitioner urged that the amendment of the claim to conductor means "embedded in the table" instead of "carried by the table", limited the claim to the precise form of conductor means disclosed in the drawings of the patent, which was a metal ring embedded in the table top. This Court rejected that contention and held the claim to be infringed by all forms of defendant's devices to which the language of the claim properly applied.

The error of the Court of Appeals for the Second Circuit in the case at bar is plain. The added drawing and the description which the Court designates as "the second passage" was not included to meet a rejection of the claim as too broad, but in order to meet the Examiner's criticism of the specification of the first filed application as an insufficient disclosure. In meeting that objection the patentee complied with the statutory requirement that he disclose in detail the preferred embodiment of his invention.*

Even the broadest and most basic invention must be disclosed in detail to comply with the statute, but the scope of the patent, whether generic or specific, is determined by the claims of the patent and not by the details of the particular embodiment selected for illustration. **It is impossible to illustrate a genus in a drawing without also illustrating a species.** *One may make a word picture of a genus to include several species, and the patent claim, according to the American patent procedure, is intended to be such a word picture.* If the ruling of the Court of Appeals

*Sec. 4888. (U. S. C., title 35, sec. 33.) Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, *and the best mode in which he has contemplated applying that principle . . .*" (Emphasis ours)

for the Second Circuit is allowed to stand, any addition to the description and drawing of a patent application will create a file wrapper estoppel so limiting the patent that it can be infringed only by an exact Chinese copy of the particular device selected for illustration.

II.

The ruling of the Court of Appeals for the Second Circuit that additions to the specification and drawings create a file wrapper estoppel limiting the claim to the precise structure illustrated is in direct conflict with decisions of Courts in the First and Third Circuits.

In *Manhattan General Construction Co. v. Helios-Upton Co.*, 135 Fed. 785, the precise question here presented arose before the Circuit Court for the Eastern District of Pennsylvania. The ruling of that Court was directly contrary to the ruling here.*

On a similar state of facts the District Court for the District of Massachusetts in the case of *A. S. Boyle Co. v. Siegel Hardware & Paint Co.*, 26 F. Supp. 217, also held that amendments to the specifications did not create an estoppel unless incorporated in the claims to secure their allowance.

These cases are consistent with the doctrine of file wrapper estoppel as repeatedly set forth in the decisions of this Court and the Courts of these two Circuits.

It is believed that an authoritative ruling of this Court on the question here presented would be a valuable supplement to the opinion of this Court in *Exhibit Supply Company v. Ace Patents Corporation*, *supra*. In that case the

*"Claims of a patent are to be taken as they read, and are not limited by an amendment of the specification more particularly describing the device shown in the drawings to meet objections of the Patent Office, where the claims themselves are left unchanged." (Syllabus 9)

scope of the estoppel arising out of an amendment to the claims is authoritatively decided. A ruling by this Court on the estoppel created by amendments to the specifications will go far toward clarifying the whole subject.

III.

The question presented here is one of public interest.

It has been generally accepted since the creation of the patent system in this country that the consideration which the patentee pays for the limited monopoly secured to him by his patent is the full disclosure in the specifications of his patent, of his invention. He is required by statute to "explain the principle thereof, and the best mode in which he has contemplated applying that principle" (R. S. 4888, U. S. C. Title 35, Sec. 33).

Beidler v. United States, 253 U. S. 447, 453 (1920):

"Ever since *Grant v. Raymond*, 6 Pet. 218, 247, it has been consistently held that a correct and adequate description or disclosure of a claimed discovery (which, in the case of a machine, involves particularly the operation of it) is essential to the validity of a patent, for the reason that such a disclosure is necessary in order to give the public the benefit of the invention after the patent shall expire. The source of the power to grant patents, and the consideration for granting them, is the advantage which the public will derive from them, especially after the expiration of the patent monopoly, when the discoveries embodied in them shall become a part of the public stock of knowledge."

It is as much the duty of the Patent Office to require specifications and drawings to fully and adequately describe "the best mode of applying the principle" of the invention as it is to see to it that the claims do not cover

more than the applicant is entitled to. By our system the specification and claims are separate and distinct and a patent to a broad and basic invention should contain in its specification the same detailed disclosure in the full and exact terms required by the statute as a narrow patent to a small improvement in a highly developed industry.

If the rule of the Second Circuit as announced in this case is allowed to stand, inventors, when called upon to amplify their specification, will be reluctant to do so because they will thereby limit the claims, however broad their terms may be, to the specific details disclosed in the amended specification.

Conclusion

It is urged, therefore, that the petition for writ of certiorari be granted.

Respectfully submitted,

H. STANLEY MANSFIELD

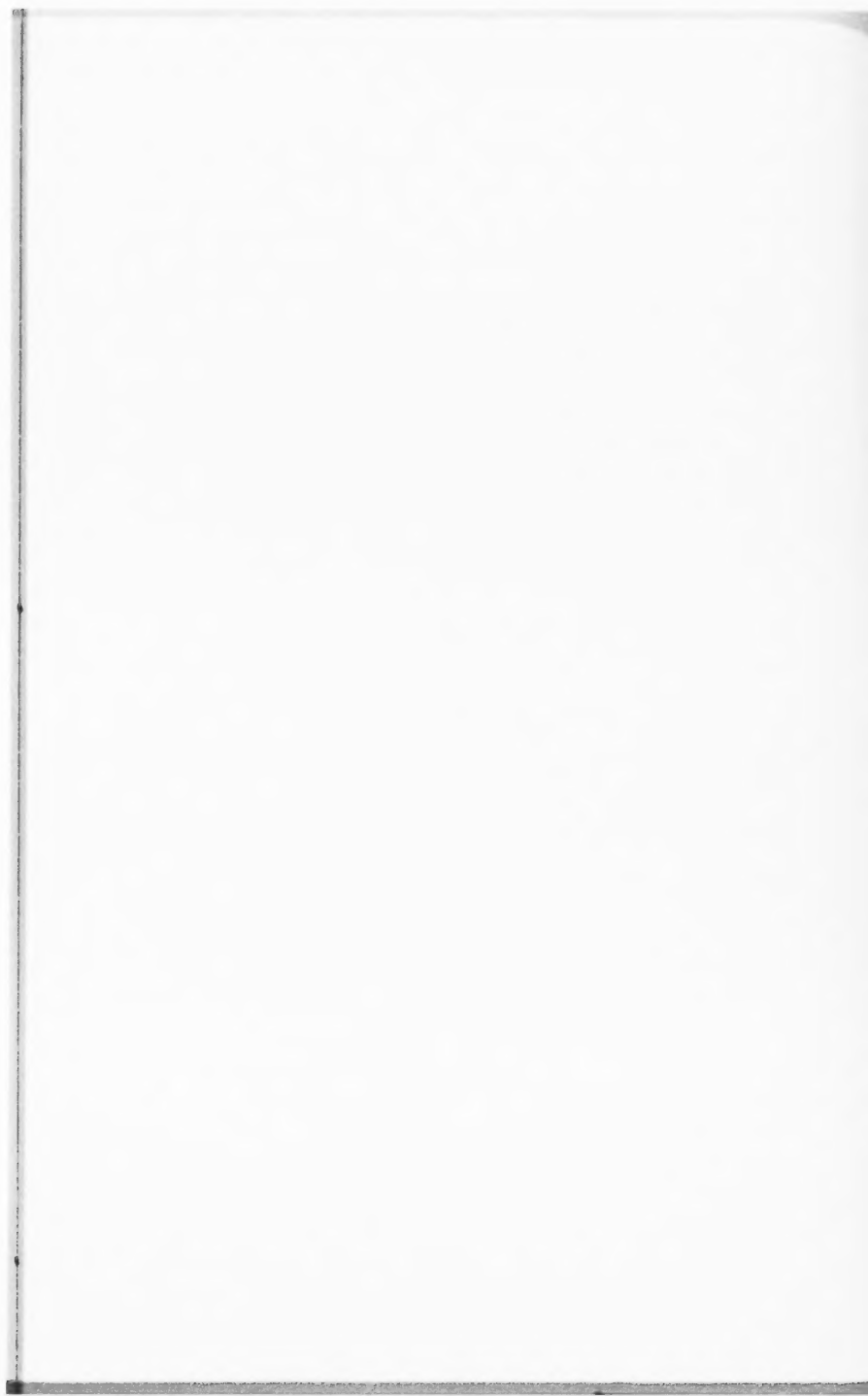
W. BROWN MORTON

Counsel for Petitioners

Dated: New York, N. Y.

March 6, 1942.





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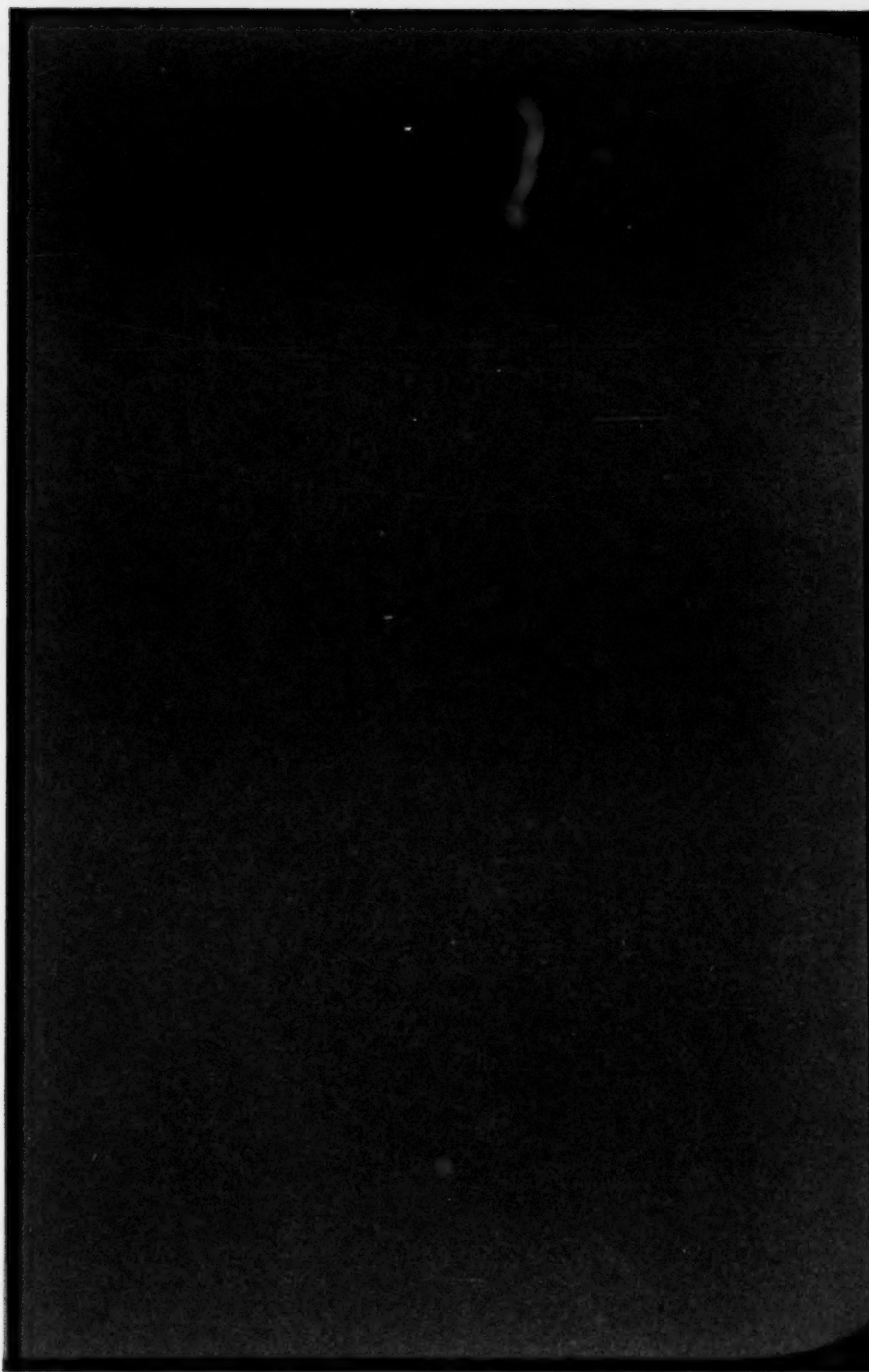
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HIGHLAND PHARMACY,

Respondents.

**RESPONDENTS' BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

STEPHEN H. PHILBIN,
KENNETH PERRY,
ALBERT J. FITZPATRICK,
WILLIAM J. BARNES,

Attorneys for Respondents.



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RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This is an ordinary suit for alleged patent infringement, in which the district court (R. 498), 38 F. Supp. 663, and the Second Circuit Court of Appeals (R. 505), 123 F. 2d 722, each held that petitioners' patent was not infringed, the latter court denying a petition for rehearing on December 10, 1941 (R. 518).

Because this is the only suit in which petitioners' patent has been adjudicated, there is no conflict of decisions regarding it.

Nor is there any special or important reason for granting this petition, as is required by Rule 38, subdivision 5, of this Court.

The only question in the present suit was whether a specific limitation in a patent claim, added to obtain the claim, should be disregarded, or whether, as decided by this Court in *I. T. S. Co. v. Essex Co.*, 272 U. S. 429, 444 (cited *infra*, p. 5), and by the courts below, it should be considered in deciding what the claim covered.

The petition for the writ erroneously states (p. 3):

“The question presented by this case is the following:

“Does the amplification of the specification and drawing, whether by amendment or by a ‘continuing’ application, to show in greater detail the preferred embodiment of the invention, restrict the scope of the claims to the added details?”

But that is not the question. The controlling issue was whether a patent claim to a “convoluted strip” should be construed as though the “convoluted” limitation were absent, especially when that limitation was deliberately inserted after unsuccessful attempts to obtain a broader claim.

And the “Reasons for Granting the Writ” submitted by the petition (p. 3), based as they are upon the same error as the “Question Presented”, are equally impertinent.

The theory of petitioners is fairly stated in their Specification of Errors (p. 5), where they say that the Circuit Court of Appeals erred—

“1. In holding that the scope of claim 1 is limited by ‘file wrapper estoppel’ to the precise construction illustrated and described in the drawings and specification.”

and again in their brief (p. 6) they say:

“In the case at bar the Court of Appeals in its opinion expressly holds that the claim in suit cannot be given a construction commensurate with its terms but must be construed as limited to the precise embodiment of the invention illustrated in the drawings.”

By these and other statements of similar nature, petitioners argue that the effect of the Circuit Court of Appeals decision is to establish the rule that a patent “can be infringed only by an exact Chinese copy of the par-

ticular device selected for illustration" (brief, p. 10). But the plain fact is that the court made no such holding, as a reading of its short per curiam opinion (R. 505) will show. Like the district court, it simply found that there was no infringement, because the respondents' product was not "convoluted", as called for in the single claim in suit.*

The pertinent facts on the issue of infringement are simple.

Haas, petitioners' patentee, filed a patent application for a catamenial pad, comprising a strip of cotton with a string sewed along the length thereof. This strip was simply pushed into a die and compressed to such a degree that it retained its compressed form upon removal from the die. Such creases as were present in the finished strip were merely the haphazard, unpredictable creases resulting from the compression.

While this application was pending, Haas attempted to secure claims which called for a "convoluted" strip, which was something more than such a normally creased strip. But the Patent Office rejected these claims and Haas cancelled them, allowing his patent to issue without any such claims.

In a second, later filed application, which matured into the patent in suit, Haas illustrated (R. 180, Fig. 2) and stated that the cotton strip was arranged in definite, pre-formed "convolutions" prior to its insertion in the die, saying (R. 181, line 90):

"The next step in the manufacture of the device is to fold the pad 11 into convolutions such as shown in Fig. 2 to reduce the length thereof. This folded con-

* This claim reads as follows:

"1. A catamenial device comprising: a highly compressed, self-sustaining, absorbent core; and a flexible member secured to and depending from said core to form a withdrawing member, said core comprising a compressed, convoluted strip of absorbent material, said core being considerably shorter than said strip."

voluted pad is then placed into a die and pressed under high pressure on both sides and the end to form a hard cylindrical core 13 with the withdrawing member 12 extending therefrom."

In this application, he succeeded in getting claim 1 in suit, which calls for a "convoluted" strip.

The manufacturer of respondents' article starts with an ordinary cotton strip, ties a string around its middle, folds the strip in two over the string, inserts it in a die, allowing the creases to come where they will, and finally compresses the cotton until it becomes a self-sustaining wad.

The patent to Pond (R. 433) which is prior art to Haas, discloses respondents' tying and folding process. In this connection the district court said (R. 473):

"The defendant in the manufacture of its tampon, of which complaint is made in this case at bar, essentially follows the disclosure of that patent [Pond] in contrast to the first patent in suit."

The idea of forming compressed wads of cotton, or tampons, to absorb body fluids was also old, as shown in a trade publication which issued prior to 1898 (R. 467), and the use of a die to compress cotton into small wads of any desired form was, of course, old prior to Haas (Johnson patent, R. 429; Casevitz patent, R. 438).

With these facts in the record, neither of the lower courts had any difficulty in finding non-infringement. Thus the district court said (R. 476):

"The prior art does show that haphazard creases naturally and necessarily result from longitudinal compression, and I saw the demonstration on behalf of the defendant in Court, and that is exactly what took place in the making of defendant's device. I entirely disagree with plaintiff's contention that there is any convolution in defendant's device as is described in the first patent in suit."

and (R. 479):

“The defendant’s device does not have the pre-compression step of Fig. 2, of the first patent in suit, and does not infringe.”

And the Circuit Court of Appeals, after reviewing the prosecutions of the two Haas patents, referred to above, said (R. 507):

“If Haas wished to insist upon all kinds of ‘convolutions’ which might result from high pressure, he was not free to abandon haphazard ‘convolutions’ and then assert that the claim covered them.”

The same principle was declared in *I. T. S. Co. v. Essex Co.*, 272 U. S. 429, 444:

“By the limitation of the claims in the Patent Office proceeding to the three-point-contact lift the patentee made this precise form a material element, and having thus narrowed the claims, cannot, as was said in the *Weber Electric Company* case, now enlarge their scope by a resort to the doctrine of equivalents. This would render nugatory the specific limitation.”

Conclusion.

The courts below were correct in deciding that there was no infringement. No reason appears for the grant of a writ of certiorari.

The petition should be denied.

Respectfully submitted,

STEPHEN H. PHILBIN,
KENNETH PERRY,
ALBERT J. FITZPATRICK,
WILLIAM J. BARNES,
Attorneys for Respondents.

March, 1942.



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REPLY BRIEF FOR PETITIONERS

H. STANLEY MANSFIELD
W. BROWN MORTON

Counsel for Petitioners



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REPLY BRIEF FOR PETITIONERS

The sole answer of respondent to the petition for certiorari is the assertion that the question stated to be presented by the decision of the Circuit Court of Appeals for the Second Circuit was not in fact presented by that decision. This is a question of fact. There can be no disagreement about a fact. There may be a mistake of fact and therefore an innocent misstatement of it. Respondent's counsel before this Court represented respondent in the Circuit Court of Appeals and it is difficult to believe that they are ignorant as to the questions decided by the Circuit Court of Appeals in its decision. We are therefore constrained to believe that the assertion that the stated ques-

tion is not presented by the decision of the Circuit Court of Appeals is made solely because of the unfamiliarity of this Court with the record.

Petitioner did not anticipate that respondent's answer would raise a controversy as to record facts, and we are therefore filing this reply to respondent's brief to aid the Court in making such examination of the record as may be necessary to determine the truth or falsity of respondent's statement.

The following are the record facts which admit of no dispute. The application of the Haas original patent No. 1,926,900 (R. 188) disclosed no convolutions at all, either "regular" or "haphazard". In the prosecution of that application Haas presented a claim (Cl. 17, R. 279), wherein he introduced convolutions for the first time, but with no limitations to *regular* convolutions as distinguished from *haphazard* convolutions. The claim was rejected in that application on the ground that there was no basis for the claim in the disclosure—no convolutions of any kind being illustrated or described (R. 282). The patentee cancelled the claim without prejudice to its presentation in a continuing application (R. 286), and promptly filed the application for the patent in suit (R. 180, 191, 201) with a claim identical with the claim cancelled from the first application and with the specification amplified to show and describe the *regular convolutions* resulting from the method of manufacture then employed by the patentee. This additional matter describing the regular convolutions is what the Circuit Court of Appeals for the Second Circuit has designated in their opinion as the "second passage", and it was the introduction of this second passage on which the Court of Appeals based its ruling that the claim was limited to *regular convolutions*, and therefore excluded the haphazard convolutions of the defendant's tampon, notwithstanding the broader language of the claim itself. In the language

of the Court's opinion the patentee "by the introduction of Figure Two and the 'second passage' . . . introduced the element that the 'convolutions' must be *regular zig-zags*" (R. 506, emphasis ours).

The error of the Court of Appeals is expressed in this statement and the one immediately following: "Obviously it made no difference that this limitation was incorporated into the claim *only by reference*" (R. 506, 507, emphasis ours).

A claim defining an element broadly as a "convoluted strip" should not be construed as limited to "regular zig-zag" convolutions by the addition to the specification and drawings of the disclosure of a particular form of convoluted strip wherein the convolutions were regular zigzags.

It is petitioner's contention that the Court of Appeals was in error in holding that "the introduction of Figure Two and the 'second passage' " in the specification of the continuing application "incorporated into the claim" any limitation "by reference" or otherwise. It is this error of the Circuit Court of Appeals for the Second Circuit which petitioner asks this Court to review. The petition accurately states the question thus erroneously decided.*

In stating the contrary, on page 2 of its brief, respondent has disregarded both the record facts and the plain language of the Court's opinion. Petitioner did not, as here stated by respondent, contend that the patent claim "should be construed as though the 'convoluted' limitation were absent". The opinion of the Court of Appeals correctly expresses petitioner's contention, namely, that the claim is not confined by the expression "convoluted" to

*Does the amplification of the specification and drawing, whether by amendment or by a "continuing" application, to show in greater detail the preferred embodiment of the invention, restrict the scope of the claims to the added details? (Petition, p. 3).

"regular zigzag folds" as distinguished from haphazard folds, but the Circuit Court of Appeals decided against petitioner because of the alleged file wrapper estoppel.

It is not denied by respondent that the decision of the Circuit Court of Appeals, so construed, is directly contrary to the ruling of the decisions of the Courts in the First and Third Circuits, referred to on page 4 of the petition, and also in direct conflict with the doctrine of file wrapper estoppel as expressed by this Court in *Exhibit Supply Co. v. Ace Patents Corporation* (decided February 2, 1942) as alleged in our petition.

Respectfully submitted,

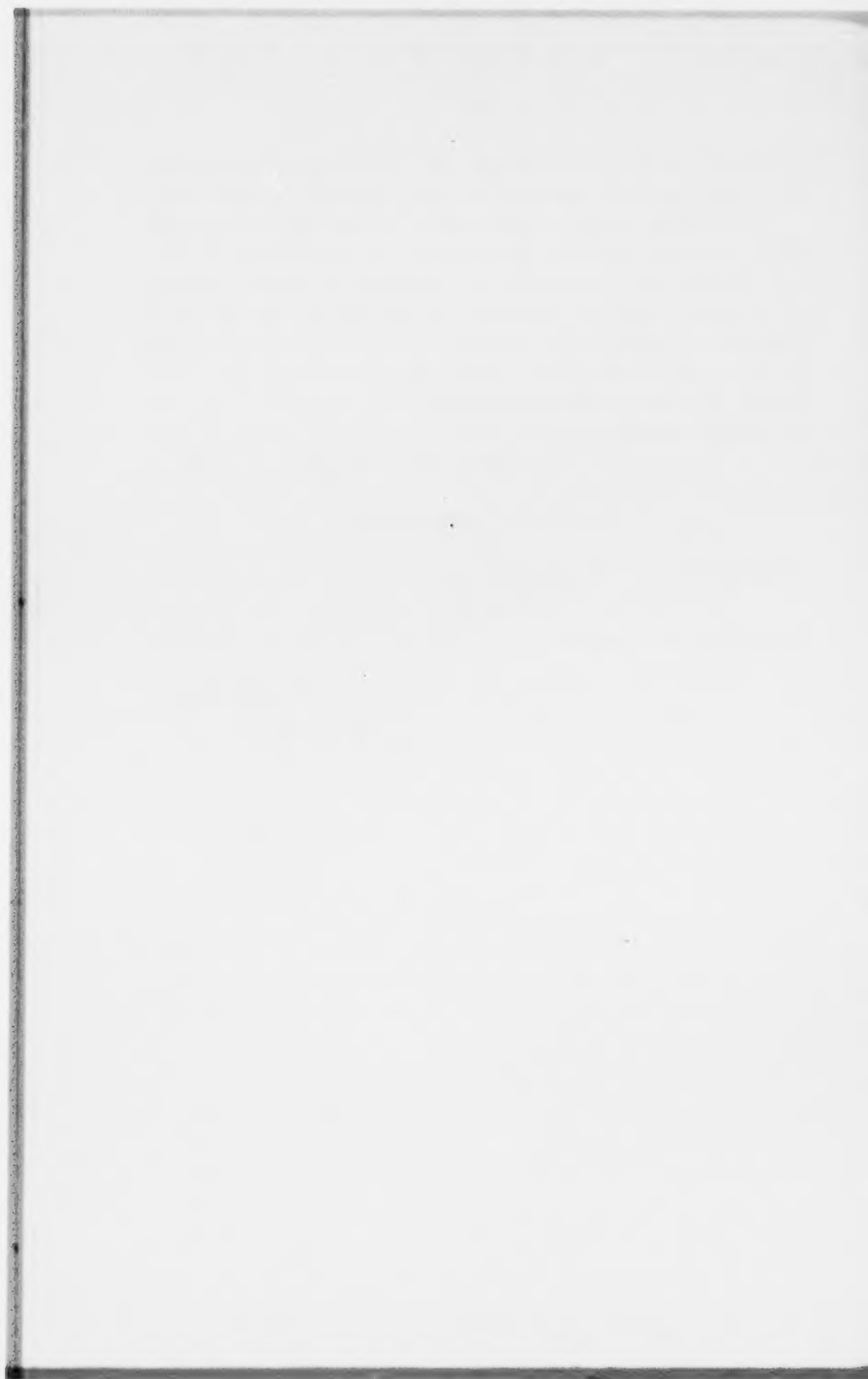
H. STANLEY MANSFIELD

W. BROWN MORTON

Counsel for Petitioners

Dated: New York, N. Y.

April 2, 1942.



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Supreme Court of the United States

OCTOBER TERM, 1941

No. 1024

**TAMPAX INCORPORATED and TAMPAX
SALES CORPORATION**

Petitioners

vs.

**THE PERSONAL PRODUCTS CORPORATION and
ISIDORE H. SCHWARTZ, trading as HIGHLAND
PHARMACY**

Respondents

PETITION FOR REHEARING

**H. STANLEY MANSFIELD
W. BROWN MORTON**

Counsel for Petitioners



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PETITION FOR REHEARING

Now come Tampax Incorporated and Tampax Sales Corporation, the above named petitioners, and respectfully petition for rehearing in the above entitled cause, for the following reason:

The Circuit Court of Appeals of the Second Circuit decides more patent cases than any other Circuit Court of Appeals. The importance attached to its rulings is second only to the importance attached to the rulings of this Court. The ruling of the Circuit Court of Appeals of the Second Circuit for which a review is sought by our Petition for Certiorari is that claims presented in a "continuation-in-part application" which contains an amplified and more detailed disclosure than the original application

are limited to the specific structure disclosed in the amplified disclosure, notwithstanding the broader language of the claims.

Continuation-in-part applications take the place of applications for "patents of addition," which are authorized by the laws of most foreign countries, but for which our laws make no provision.

The disclosure of the original application filed by an inventor is frequently based on his laboratory or experimental shop experience. After it is filed, if his invention goes into actual manufacture, he frequently finds his original disclosure is erroneous or insufficient in part. His remedy is to file a continuation-in-part application amplifying the original disclosure on the basis of his later-acquired knowledge. The new application gets the benefit of the date of the old application for so much of his disclosure as is common to both, and the date of the new application for the new matter.

The continuation-in-part practice is a distinct benefit to the public, as it provides the only way in which an inventor may safely give to the public the full details acquired by his manufacturing experience. If, however, by filing a continuation-in-part application the inventor is limited to a narrow and detailed patent, he will base his claims on his original application and the public will be deprived of the benefits of his more amplified detail specification.

It would be a great benefit to the patent system for this Court to make an authoritative ruling on this important question of continuation-in-part applications. It is particularly important that this be done now, for the reason that the patent statutes are being reviewed by the Senate Committee on Patents with a view to a general revision, and an authoritative ruling by this Court on this question will be most helpful in determining the need for statutory provisions for patents of addition.

For the foregoing reason it is respectfully urged that the Petition for Certiorari be reconsidered, that the order de-

nying the Writ of Certiorari be vacated and that a Writ of Certiorari be issued forthwith to review the decree of the U. S. Circuit Court of Appeals for the Second Circuit heretofore entered in this case.

Respectfully submitted,

H. STANLEY MANSFIELD

W. BROWN MORTON

Counsel for Petitioners

Dated: New York, N. Y.

April 27, 1942.

Certificate of Counsel

I, W. Brown Morton, counsel for the above-named Petitioners, do hereby certify that the foregoing Petition for a rehearing in this cause is presented in good faith and is not filed for delay.

W. BROWN MORTON

Counsel for Petitioners